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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,575	10/17/2003	Matthew Brown	49480-051	8953

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McDermott, Will & Emery
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

MANLOVE, SHALIE A

ART UNIT PAPER NUMBER

1755

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/686,575

Applicant(s)

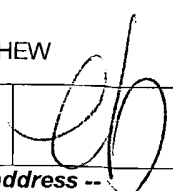
BROWN, MATTHEW

Examiner

Shalie A. Manlove

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-50 is/are pending in the application.
- 4a) Of the above claim(s) 36-43 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 47 is/are allowed.
- 6) ☒ Claim(s) 44-46 and 48-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This application contains claims 36-43 drawn to an invention nonelected with traverse in Paper dated May 27, 2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Withdrawn Objections/ Rejections

1. The Specification and claim objections are withdrawn due to Applicant's amendment.
2. The 35 U.S.C. 112 rejections of record have been withdrawn due to Applicant's amendment.
3. The 35 U.S.C. 103 rejections over Terry et al US 3,769,050 due to applicant's amendment.

Repeated Rejections

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

Determining the scope and contents of the prior art.

Ascertaining the differences between the prior art and the claims at issue.

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Resolving the level of ordinary skill in the pertinent art.
Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 44-46 and 48-49 rejected under 35 U.S.C. 103(a) as being unpatentable over Babel et al US 5,296,285.

Babel discloses in claims 1-7, a coating for a substrate of aluminum or aluminum alloy. The coating comprising potassium silicate binder and zinc oxide particles, wherein the amount of particles in the binder range from 50-90% by weight and inherently the binder is present in range from 10-50% by weight. Babel also teaches in claim 7, that sufficient water was added to produce a coating with properties of solar absorptance and infrared emittance. The reference reports weight percent instead of weight ratios, however converting the claimed ratio to percent yields a zinc oxide range of 54-59% by weight and vehicle-binder range of 41-46% by weight and thus presents overlapping ranges. A prima facie case of obviousness typically exists when the range of acclaimed composition overlap the ranges disclosed in the prior art. In re Malagari, 499 F2d 1297, 1303, 182 USPQ 549,533 (CCPA 1974).

New Rejections

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 50 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described

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in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Specification teaches the pigment includes, approximately ½ % by weight of the dispersing agent, propionic acid. The Specification does not teach the dispersing agent, **propionic acid in an amount equal to approximately ½ % of the binder by weight**. Therefore, claim 50 is without support and constitutes new matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 44-46 and 48-49 are rejected under 35 U.S.C. 102(b) as being anticipated by I I T Research Institute Z93-P Thermal Control Coating Kit (MSDS).

The research institute teaches a coating for thermal control comprising a mixture of 498-502 grams of calcined zinc oxide particles, and 332-334 or 389-391 grams of potassium silicate binder in distilled water (p. 8 of 13). Applicant teaches the ratio of weight of pigment to weight of binder is between 1.41: 1 and 1.15: 1 wherein the reference teaches the ratio range to be 1.27:1 to 1.29:1.

Allowable Subject Matter

10. Claim 47 is allowed as previously stated.

Response to Arguments

11. Applicant's arguments filed 9/27/04 have been fully considered but they are not persuasive. The Applicant argues that the reference does not teach a non-calcined zinc oxide.
12. **The reference teaches the claimed zinc oxide and a water content of 46% by weight in col. 5 lines 30-36 and nowhere is it stated that the coating comprises calcined zinc oxide therefore, the reference is considered to read upon the claimed limitations absence the showing of convincing evidence to the contrary. There is no apparent difference between uncalcined zinc oxide and calcined zinc oxide. Since the only apparent difference is price then one of ordinary skill in the art would find it obvious to use the more economical of the two i.e. the uncalcined zinc oxide.**

Conclusion

Applicant's amendment and submission of prior art necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shalie A. Manlove whose telephone number is (571) 272-1372. The examiner can normally be reached on M-TH 6:30-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on (571) 272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shalie A. Manlove
Examiner
Art Unit 1755

December 1, 2004


MELISSA KOSLOW
PRIMARY EXAMINER